

**REMARKS/ARGUMENTS**

Upon entry of the instant amendment, claims 27, 28, 30-33, 35-42 will be amended, whereby claims 27, 28, 30-33 and 35-42 will remain pending. Claims 27, 33, 39 and 42 are independent claims.

Applicants note that the claims have been amended herein to delete reference to solvates and hydrates, to delete  $R^2$  being a halogen atom in claim 27, and to utilize other language than Markush language in claims 40-42.

Reconsideration and allowance of the application are respectfully requested.

**Discussion of Telephone Interview**

Applicants express appreciation for the courtesies extended by the Examiner during an October 11, 2006 telephone interview with Applicants' representative Arnold Turk.

During the interview, Applicants representative initially noted that claim 33 is not rejected based upon Skulnick, and the Examiner confirmed that claim 33 is not rejected based upon Skulnick.

It was proposed that claim 27 be amended to delete halogen from the definition of  $R^2$ . The Examiner indicated that such amendment would overcome the rejection based upon Skulnick.

Arguments were presented with respect to the rejection based upon Tani, and the Examiner indicated that the rejection could be overcome by submitting unexpected results in a Declaration comparing the compound of Tani with representative compounds claimed by Applicants. The Examiner indicated that representative compounds could include compounds wherein  $R^4$  is hydrogen,  $R^5$  is methyl, and W is a single bond for claim 27, and wherein  $R^4$  is hydrogen,  $R^5$  is, and

W is a single bond for claim 33.

Regarding the 35 U.S.C. 112, first paragraph, rejection, the Examiner indicated that he would consider arguments and/or amendments when submitting the written response.

#### **Clarification Of Office Action**

Applicants note that the claims pending in the application are claims 27, 28, 30-33 and 35-42. Accordingly, the Office Action is incorrect in the listing of claims as claim 35 has been omitted from this listing. However, Applicants note that claim 35 is included in the rejections based upon Skulnick and Tani.

Further, independent claim 33 is not rejected based upon Skulnick; however, claim 35-37 and 41, which depend directly or indirectly upon claim 33, are included in the rejection based upon Skulnick. It therefore appears that claims 35-37 and 41 were inadvertently included in the rejection based upon Skulnick.

Therefore, Applicants request clarification of these issues in the next communication from the Patent and Trademark Office.

#### **Consideration Of Information Disclosure Statement**

Applicants express appreciation for the Examiner's consideration of the Supplemental Information Disclosure Statement, filed January 31, 2006, by including an initialed copy of the Form PTO-1449 submitted therewith with the Office Action mailed May 10, 2006.

In order that the record is complete with regard to the Examiner's consideration of the cited information, Applicants note that the May 10, 2006 Office Action has been remailed as the June 20, 2006 Office Action including an updated PTO-892. However, the Examiner did not attach another copy of the initialed Form PTO-1449 nor put a check box on the Cover Sheet of the May 20, 2006 Office Action that a Form PTO-1449 was attached (despite the fact that the initialed copy of the form was received with the May 10, 2006 Office Action). Accordingly, a copy of the initialed Form PTO-1449 is attached herewith to ensure that the record is complete as to this initialed form.

**Response To Rejection Under 35 U.S.C. 112, first paragraph**

In response to the rejection of claims 27, 28, 30-33 and 36-42 under 35 U.S.C. 112, first paragraph, as the Examiner asserts that the specification, while being enabling for a compound of Formula I or a pharmaceutically acceptable salt thereof, does not reasonably provide enablement for a solvate or hydrate of a compound of Formula (I), Applicants respectfully submit the following.

The Examiner is reminded that working examples are not required. The rejection must provide clear technical reasoning to support a lack of enablement for solvates and hydrates, instead of merely pointing to documents that have disclosures broadly relating to compounds and their solvates and hydrates. In any event, in order to advance prosecution of the application, without expressing any agreement or acquiescence with the rejection of record, the claims have been amended to delete solvates and hydrates. Accordingly, this ground of rejection should be withdrawn.

**Response To Art Based Rejections**

**(a) Claims 27, 30-32, 35-37, 40 and 41 (apparently claims 35-37 and 41 are inadvertently included in the rejection as noted above) are rejected under 35 U.S.C. 103(a) as being unpatentable over Skulnick et al., "Pyrimidinones. 1. 2-Amino-5-Halo-6-Aryl-4(3H)-Pyrimidinones. Interferon-Inducing Antiviral Agents", J. Med. Chem., Vol. 28, pp 1864-1869 (1985).**

In response to this ground of rejection, Applicants once again note their arguments as presented in the Reply filed January 17, 2006, and submit that the claims prior to the present amendment are patentable at least for the arguments previously presented. However, to advance prosecution of the application, claim 27 has been amended so that R<sup>2</sup> represents a hydrogen atom. As discussed with the Examiner during the above-noted telephone interview, Skulnick discloses compounds having a halogen atom (bromine or iodine) at the 5-position.

The Examiner indicated during the above-noted telephone interview that the amendment of claim 27 to delete halogen atom at the R<sup>2</sup> would overcome the rejection based upon Skulnick. Accordingly, this ground of rejection should be withdrawn.

**b) Claims 27, 30-33, 35-37, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tani et al., JP 49035631 (also CAPLUS Abstract 84:44112).**

Initially, Applicants note that claims 28, 38, 39 and 42 are not included in this ground of rejection.

In this ground of rejection, it is asserted that the Me<sub>2</sub>N group of Tani can be modified to arrive at Applicants' compounds. With respect to claim 27, the rejection asserts that claim 27

includes NH-CH<sub>3</sub> substituent at the 2-position as compared to the 2-N(CH<sub>3</sub>)<sub>2</sub>. With respect to claim 33, the rejection asserts that claim 33 includes -NCH<sub>3</sub>)(CH<sub>2</sub>CH<sub>3</sub>) as compared to the -N(CH<sub>3</sub>)<sub>2</sub> of Tani.

In response, Applicants submit that the English abstract of Tani indicates that seven pyrimidinols useful as anti-inflammatory agents were prepared from the corresponding pyridylcarbonylacetic acid ester and guanidine derivatives. The rejection does not point to any teaching, suggestion or motivation in Tani to arrive at compounds and compositions as recited in Applicants' claims. In the instant situation, there is nothing in the prior art that teaches or suggests any type of substitution in Skulnick that would arrive at Applicants' claims.

Applicants therefore respectfully submit that the rejection does not set forth a *prima facie* case of obviousness and the rejection should be withdrawn for at least this reason.

Moreover, Applicants are submitting herewith a Declaration Under 37 C.F.R. 1.132 by one of the inventors, Dr. Kazutoshi Watanabe, referring to experiments to show the inhibitory activity of the compound disclosed in Tani (JP 49035631), as compared to compounds of the present invention against P-GS1 phosphorylation by bovine cerebral TPK1. The Examiner is referred to the table at the bottom of page 4 of the Declaration for comparison of the compounds according to the present invention as compared to a comparative compound of Tani which was revealed to have much lower inhibitory activity.

Accordingly, for this additional reason, the rejection of record should be withdrawn.

**Response To Obviousness-Type Double Patenting Rejection**

(a) Claims 27, 28, 30-33 and 35-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 4 of U.S. Patent No. 6,844,335.

(b) Claims 27, 28, 30-33 and 36-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7, and 16-35 of copending application No. 11/035,264.

In these grounds of rejection, it is contended that the claims differ by a CH<sub>2</sub> group and it is well established that compounds that differ by a CH<sub>2</sub> group are structural homologs.

In response, Applicants respectfully submit that the instantly claimed compounds have a -NH group at 3-position, while the compounds disclosed in the U.S. Patent No. 6,844,335 and Application No. 11/035,264 have a nitrogen atom at the 3-position which is substituted with functional groups other than hydrogen atom. Applicants submit that the rejection must establish that there is some teaching, suggestion or motivation to modify the compounds claimed in U.S. Patent No. 6,844,335 and Application No. 11/035,264 to arrive at Applicants' claimed subject matter.

Accordingly, these grounds of rejection are without appropriate basis and should be withdrawn.

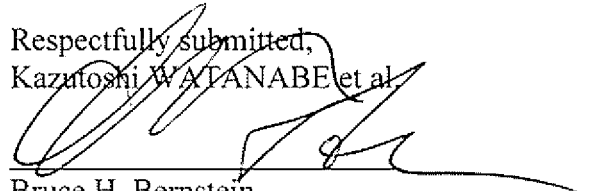
**CONCLUSION**

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow all the pending claims.

Allowance of the application is requested, with an early mailing of the Notices of Allowance and Allowability.

If the Examiner has any questions or wishes to further discuss this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,  
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